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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,711	07/18/2001	Willy Vincent Bienvenut	SYP-159	8631

7590

09/30/2003

Applied Biosystems
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EXAMINER

NAFF, DAVID M

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/889,711	BIENVENUT ET AL.	
	Examiner	Art Unit	
	David M. Naff	1651	

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____. |

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Claims examined on the merits are 1-21 which are all claims in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

5 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10 Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15 Claims 1-9 are confusing and unclear as to the components of the kit by claim 1 being unclear as to the functional relationship of components a)-c) of kit relative to each other.

To be clear as to the cleaving reagent of a), the electrophoretic gel in line 3 of the claim should be required to contain a polypeptide which has been separated by electrophoresis, and the first
20 polypeptide-cleaving reagent should be required to be capable of cleaving the separated polypeptide to produce a partially cleaved polypeptide.

To be clear as to the membrane of b), the membrane should be required to be capable of use in transblotting the partially digested
25 polypeptide from the electrophoretic gel, and the second polypeptide-cleaving reagent immobilized on the membrane should be required to be

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capable of further cleavage of the partially cleaved polypeptide to produce polypeptide fragments.

To be clear as to the hydrophobic collection member of c), the member should be required to be suitable for receiving the polypeptide fragments from the membrane of b) when transferred thereto by transblotting.

In line 3 of claim 4, there is not clear antecedent basis for "the functional groups".

In claim 8, to be clear, the gel should be required to be the electrophoretic gel containing the polypeptide separated by electrophoresis.

The method of claims 10-21 is confusing and unclear by claim 10 not being clear as to the functional relationship of the steps to each other in carrying out the method.

The gel of step a) should be required to be an electrophoretic gel, and the polypeptide should be required to be isolated on the gel by electrophoresis.

The first polypeptide-cleaving reagent of step b) should be required to be capable of cleaving the isolated polypeptide contained by the gel to produce a partially cleaved polypeptide.

The second polypeptide-cleaving reagent contained by the membrane of step c) should be required to be capable of further cleaving the partially cleaved polypeptide to produce polypeptide fragments.

The hydrophobic member of step d) should be required to be suitable for receiving thereon the polypeptide fragments from the

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membrane of step c) by transblotting. In step d), there is not clear antecedent basis for "said hydrophobic layer".

In step e), there is not clear antecedent basis for "the polypeptides", "the full gel" and "the polypeptide or polypeptides".

5 Step e) should be divided into steps of partially cleaving the isolated polypeptide on the electrophoretic gel by the first polypeptide-cleaving reagent to produce a partially cleaved polypeptide, transblotting the partially cleaved polypeptide from the electrophoretic gel through the hydrophilic membrane where the
10 partially cleaved polypeptide is further cleaved by the second polypeptide-cleaving reagent to produce polypeptide fragments, and transblotting the polypeptide fragments onto the hydrophobic collection member.

In step f), "polypeptide" should be inserted before "fragments"
15 to be clear.

Claim 11 is unclear as to which polypeptide is being further characterized. Is this the isolated polypeptide before cleavage or the partially cleaved polypeptide?

In claim 12, the gel should be required to be the electrophoretic
20 gel to be clear as to the gel intended.

In line 2 of claim 18, there is not clear antecedent basis for "the voltage". In line 4 of the claim, it is uncertain as whether transfer is through the membrane or some other transfer. In the last line of the claim, it is uncertain as to which cleavage reagent is
25 required, i.e. the first or second.

In the last line of claim 19, the meaning of "biased" is uncertain,

In the line 2 of claim 20, "polypeptide" should be inserted before "fragments".

5 Claim 21 is unclear as to which polypeptide is identified by the membrane being scanned. The polypeptide should be required to be the polypeptide fragments.

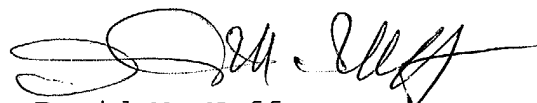
The claims are free of the prior art.

Any inquiry concerning this communication or earlier
10 communications from the examiner should be directed to David M. Naff whose telephone number is 703-308-0520. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 703-308-
15 4743. The fax phone number for the organization where this application is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0196.

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David M. Naff
Primary Examiner
Art Unit 1651

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